IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 14070 SEPTEMBER TERM, 1963 JANUARY SESSION, 1964

ERNST JOHAN JENS HENRIKSEN and W. A. SHEAFFER PEN COMPANY, *Plaintiffs-Appellees,*

v.

CORY CORPORATION, *Defendant-Appellant.*

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

January 20, 1964

Before HASTINGS, *Chief Judge*, DUFFY and CASTLE, *Circuit Judges.*

DUFFY, *Circuit Judge.* This is a suit alleging infringement of Henriksen Patent No. 2,678,634 issued on May 18, 1954, and entitled "Writing Instrument."

Co-plaintiff, W. A. Sheaffer Pen Company, acquired from Henriksen an exclusive right to make, use and sell in the United States, writing instruments embraced within the scope of the claims of the Henriksen patent.

The patent in suit relates to the construction of a ball-point pen. The specification describes the pen as including an ink reservoir and a writing ball mounted in a nib in the forward end of the reservoir. Two vents are provided in the rear end of the reservoir in order to prevent a vacuum from forming in the air space above the ink as the ink is withdrawn from the reservoir during the writing operation.

The defendant asserts the invalidity of the patent in suit, claims non-infringement and urges as a further defense, the alleged misuse of Henriksen Patent No. 2,678,634.

The principal issue in the suit pertains to what is designated as the "follower." In the writing instrument described in the patent in suit, during writing, ink is fed by gravity to the writing ball. The diameter of the reservoir is such that if the pen is inverted, the ink would normally flow rearwardly through the vent and out of the reservoir. To prevent such a flow of the ink, a follower is inserted in the reservoir and is positioned on the upper surface of the ink. Another purpose of the follower is to prevent air mixing into the ink which might form bubbles and thus interfere with the writing functions of the pen.

The follower is frequently referred to as "follower mass." This follower must be other than ink and is of such a character that it does not mix with ink.

The pens manufactured and sold by defendant all have an ink reservoir, a writing ball and a follower. However, defendant claims that its follower has a composition different from the one claimed in the patent in suit, and hence there is no infringement.

Henriksen, the patentee, does not claim to be the originator of ballpoint pens or of such pens with a follower. All of the claims of the Henriksen patent are directed to a follower which is "pulpy."

On July 1, 1955, plaintiff Henriksen granted to co-plaintiff, W. A. Sheaffer Pen Company, a license which was designated "exclusive." Under the terms of the license agreement, Sheaffer was required to grant licenses to seven other pen manufacturers who were named in the license. One additional licensee was provided for, who was to be selected by mutual agreement of Sheaffer and Henriksen. The license to Sheaffer specified the precise nature and form of the sublicenses which Sheaffer was required to

grant. Included was the provision that such sublicensees must accept a license not only under the patent in suit, but under various foreign patents, and to pay minimum royalties on both United States and foreign sales.

The District Court held the patent in suit valid, and that it was infringed by defendant's writing instrument. Also, the District Court failed to find that plaintiffs had misused the patent in suit.

Although defendant's claim of invalidity was strongly urged in the District Court, that issue has been virtually abandoned on this appeal. In any event, we are of the view that the finding and conclusion of the District Court that the patent is valid, is justified by the record before us.

On the question of infringement, it is undisputed that defendant's follower is composed of Texas Star "O" grease.[1] This grease is a common lubricating grease and, therefore, is a "greasy substance." Defendant strongly urges that Henriksen clearly disclaimed followers which were of a greasy substance, and that he is now attempting to assert that the "pulpy" claims in the patent in suit cover followers made up from a greasy substance.

Defendant relies on the well-established principle that a patentee cannot regain in court, claims covering devices which he specifically abandoned in the Patent Office. *North Star Ice Equipment Company* v. *Akshun Manufacturing Company*, 7 Cir., 301 F. 2d 882, 886.

As originally filed, Henriksen's application described the followers in this language:

> "6 is a lid or follower slidably mounted within the ink reservoir 3 adjacent the surface of the ink or paste 7 contained therein. This lid or follower which may be a cylindrical body of small weight f. inst. a

[1] In the transcript and in appellees' brief, the grease is referred to as Texas Star "O" grease. In appellant's brief it is called Texaco Star "O" grease.

body of light metal or a solid or semi-pasty body of a composition of paraffin or may consist of a substance having approximately the same viscosity as the ink but of such a nature that it is unable to mix therewith, is adapted to prevent the air admitted through the air intake 5 to contact the surface of the ink 7 and also to prevent the ink from flowing from the reservoir into the interior of the barrel.

"Alternatively the lid or body 6 may consist of a layer of viscous or pulpy mass of substantially the same viscosity as the ink and having a color which is distinctly different from the color thereof, thereby providing means for advertising the user when the ink in the reservoir is approaching exhaustion which will become apparent from the change of color on the writing paper when the pulpy mass above the ink column is extracted through the ink feeding channel to the writing ball."

The original specification thus appears to divide followers into two groups. In the first, the follower is a body of light metal or a solid or semi-pasty body of a composition of paraffin; and, in the second, the follower may be a viscous or pulpy mass similar in viscosity to the ink, but of a different color so as to advise the user when the ink in the reservoir is near exhaustion.

Some two years after the filing of the original application, Henriksen added the following three claims:

"28. In an ink reservoir for ball point fountain pens including an ink column within said reservoir; a viscous mass adjacent the surface of said ink column and providing an air tight follower above said ink column within said reservoir, said viscous mass being of such a nature that it is unable to mix with said ink.

"29. In an ink reservoir for ball point fountain pens including an ink column within said reservoir; *a layer of a greasy substance* above the surface of said ink column, said greasy substance forming an air tight follower capable of sliding within said reservoir following the surface of said ink column, the nature of

said greasy substance being such that it is unable to mix with said ink.

"30. In an ink reservoir for ball point fountain pens including a column of pulpy ink within said reservoir; *a layer of a pulpy mass* on the surface of said ink column, said pulpy mass having substantially the same viscosity as the pulpy ink and forming a slidable follower within said reservoir, said pulpy mass and said pulpy ink being immiscible with each other." (Emphasis supplied).

In arguing these new claims, Henriksen took the position that Claim 29 is limited to followers which are "greasy"; that Claim 30 is a claim to a different species in one of which the follower is "pulpy" while Claim 28 is the generic claim covering both species, stating: "Claims 29 and 30 are directed to the species of a greasy substance and pulpy mass, respectively, as species to which Claim 28 is generic."

In the same amendment, after emphasizing that "pulpy" is something different from "greasy", applicant stated: "Applicant further elects as a single species for the lid a lid of pulpy mass in the event that no generic claim should be found allowable." This election of species was made under Rule 41[2] of the Patent Office.

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[2] "41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application: *Provided*, That more than one species of an invention, not to exceed three, may be claimed in one application if that application also includes an allowable claim generic to all the claimed species. In the first action on an application containing a generic claim or claims and claims to more than one species thereunder the examiner, if he is of the opinion after a complete search that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable."

Under Rule 41 of the Patent Office, where generic claims are rejected and claims to independent species remain, the applicant must elect a single species "to which his claims shall be restricted." Henriksen elected the "pulpy" species.

Claims 28, 29 and 30 were rejected by the Patent Office on the prior art, were reargued by the applicant, again rejected by the Patent Office, and were finally cancelled by Henriksen who substituted therefor Claim 31 (the latter became Claim 1 of the Patent), which claim called for the follower to be "pulpy."

We agree with plaintiffs that, generally speaking, one device is an infringement of the other if it performs substantially the same function in substantially the same way to obtain the same result. In other words, if two devices do the same work in substantially the same way and accomplish the same result, they are the same even though they may differ in name, form and shape.

In the case at bar, we would hold there was infringement of the patent in suit by defendant's pen were it not for the file wrapper estoppel and Henriksen's election under Rule 41 of the Patent Office whereby Henriksen clearly abandoned a "greasy" follower and limited his patent to the "elected species" where the follower is "pulpy."

Pertinent is the language in *Hubble* v. *United States*, 179 U.S. 77 where the Court stated at pages 83-84: ". . . [L]imitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public and looked upon as in the nature of disclaimers."

Also pertinent on this point is the statement of this Court in *North Star Ice Equipment Company* v. *Akshun Manufacturing Company*, 301 F. 2d 882, 886: "Had Claim 13 been allowed, it might well have covered the one part accused North Star blade, but since it was rejected and

cancelled by the applicant, the assignee of applicant is estopped to broaden by interpretation, the claims of its patent to embrace that which was given up in the Patent Office."

It is urged that we are bound by the District Court's findings. It is true there were three findings below which state or imply that grease may be considered as a pulpy mass. All of the findings in the instant case were entered in the precise form submitted by plaintiffs' counsel. The District Court did not file an opinion or otherwise discuss the applicable law.

The situation here is similar to that in a case recently considered by this Court. In *Taylor-Reed Corporation* v. *Mennen Food Products, Inc.*, 7 Cir., 324 F. 2d 108, where the judgment below was reversed on the ground of file wrapper estoppel. We said at page 111:

> "The district court made a number of findings of fact contrary to the conclusion we have reached. Since we are able to resolve this question on the basis of documentary evidence, the findings of the district court on this issue are deprived of the degree of finality which would otherwise attach under Rule 52(a) [citing authorities] We hold, therefore, the such contrary findings on this proposition must be set aside."

Construing the patent in suit in view of its file wrapper history, we hold the District Court was in error in finding and concluding that defendant's pen infringed the claims of the patent in suit. We hold more specifically, defendant's accused writing instruments known as Autopoint 3-X, Autopoint Cargo and Autopoint Jetliner ball point pens did not infringe the patent in suit.

The third point raised by defendant is the alleged misuse of the patent in suit. Defendant relies upon the license agreements *per se*. The claim of misuse is confined to two provisions of the license agreement, 1) an alleged "package" licensing program which is said to require the licensee

to take licenses under foreign patents as a condition to receiving a grant of a license under the patent in suit, and 2) an alleged "veto" power given to Sheaffer over the grant of an additional license to one unnamed potential licensee.

It was not until June 21, 1961 that defendant filed an amended answer which alleged plaintiffs had misused the Henriksen patent. In the findings of fact, the District Court found there was no evidence that plaintiffs have collaborated in an attempt to control ball point pens or other items not properly included within the scope of the Henriksen patent. Further, that there is no evidence of any conspiracy to restrain trade in unpatented items. Also, that there is no evidence that Sheaffer grants sublicenses only to larger manufacturers of ball point pens. As a conclusion of law, the Court determined that plaintiffs had not made any agreements or engaged in any activities which constitute a misuse of the patent in suit.

Plaintiffs point out that the two items now relied on by defendant to show misuse of the patent in suit were asserted for the first time in a "Supplement to defendant's trial brief" served only four days prior to the commencement of the trial. This was four years after defendant's original answer and counterclaim were filed. There never has been a pleading of the specific items of misuse now asserted. There was no explanation by defendant for this long delay in raising these new matters. We hold the Court's rulings on evidence relating to these impleaded items were not error and we overrule the defense of misuse.

Due to our holding of non-infringement, the judgment of the District Court is

REVERSED.

A true Copy:
Teste:

Clerk of the United States Court of Appeals for the Seventh Circuit.

UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT
Chicago 10, Illinois

Monday, January 20, 1964

Before
HON. JOHN S. HASTINGS, *Chief Judge*
HON. F. RYAN DUFFY, *Circuit Judge*
HON. LATHAM CASTLE, *Circuit Judge*

No. 14070

ERNST JOHAN JENS HENRIKSEN and
W. A. SHEAFFER PEN COMPANY,
Plaintiffs-Appellees,

vs.

CORY CORPORATION,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, REVERSED, with costs, in accordance with the opinion of this Court filed this day.

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 14070

ERNST JOHAN JENS HENRIKSEN and
W. A. SHEAFFER PEN COMPANY,
Plaintiffs-Appellees,

v.

CORY CORPORATION,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

HONORABLE RICHARD B. AUSTIN, *Trial Judge.*

Petition for Rehearing.

To the Honorable Judges of the United States Court of Appeals for the Seventh Circuit:

Ernst Johan Jens Henriksen and W. A. Sheaffer Pen Company, plaintiffs-appellees in the above entitled appeal, respectfully present this petition for rehearing in said appeal on the ground that this Court's opinion dated January 20, 1964, shows a misconception of certain facts in this case, and justice requires that the decision of the District Court on the issue of infringement should be affirmed.

SUMMARY OF REASONS OF PETITION.

1. This Court's opinion fails to give effect to the fact that *witness testimony* given during the course of a four and one half day trial and other evidence of record abundantly support the finding of the District Court that Texas

Star-O grease used by defendant is a viscous pulpy mass and, under Rule 52 (a) F.R.C.P.; 28 U. S. C., such finding should not have been set aside.

2. This Court's opinion is contrary to established precedent that the withdrawal of one claim during prosecution of a patent application does not constitute an abandonment of subject matter directly encompassed within the literal language of another allowed claim and that file wrapper estoppel does not apply as to such subject matter.

3. This Court's opinion depreciates findings of fact made by the District Court for the reason that they were drafted by Plaintiffs' counsel, contrary to established precedent as exemplified by Judge Sparks' decision in *Taylor Instrument Companies* v. *Fee & Stemwedel, Inc.*, 129 F. 2d 156, 160-161 (7 Cir. 1942) and by Judge Major's decision in *Hazeltine Research, Inc.* v. *Admiral Corp.*, 183 F. 2d 953, 954 (7 Cir. 1950).

It is not intended by this petition to reargue the infringement aspects of this case inasmuch as this argument was presented on pages 27-49 of plaintiffs' main brief. However, it is an intention of this petition respectfully to direct this Court's attention to certain witness testimony presented in open court which provides ample support for the findings of the District Court relative to the scope and meaning of the term "viscous pulpy."

Reasons of Petition.

The sole basis for reversal of the District Court was noninfringement and this Court's opinion contains the statement (page 5):

> "... we would hold that there was infringement of the patent in suit by defendant's pen *were it not for the file wrapper estoppel and Henriksen's election under Rule 41** of the Patent Office. . . ."

*Emphasis added in all quoted matter unless otherwise indicated.

Plaintiffs do not dispute that during prosecution of the Henriksen patent application there was a technical election required and made between claim 29 reciting a "greasy substance" and claim 30 reciting a "pulpy mass" under Patent Office Rule 41. However, an election *per se* does not give rise to an estoppel. The estoppel arises when a claim is amended or cancelled and it extends only to subject matter embraced by the original claim which is not specifically included within the literal scope of the amended or a newly added claim. *Hunt* v. *Armour & Co.*, 185 F. 2d 722, 727 (7 Cir. 1950). The new claim 31 (which eventually became claim 1 of the patent) reads literally on defendant's accused Autopoint pens *and the estoppel extends only to greasy substances which are not viscous and pulpy.*

Witness Testimony Supports the District Court's Finding That Texas Star-O Grease Is a Viscous Pulpy Mass.

The District Court found (D. App. 416):

"58. Texas Star-O grease is a viscous pulpy material."

This finding and related findings are based upon testimony given by Dr. Carl S. Miner, Jr., at the trial and are not based solely upon documentary evidence. Dr. Miner, fully qualified as one skilled in the art (P. App. 1-2; D. App. 18-22), testified extensively at the trial concerning the compositions and properties of ball point pen inks, follower materials and greases. (P. App. 4-44, 128-39; D. App. 21-29).

Dr. Miner's testimony included the following (P. App. 10):

"Q. *Can you give exampies of viscous pulpy masses* that would serve the purpose of holding the ink in place and readily following it through the reservoir?

"A. Yes. Examples would be petrolatum, a material commonly known as vaseline—that is the trade name—*lubricating greases*, certain jelly-like material, silica jelly, for example, materials having the con-

sistency of ointments, material such as can be made by thickening a non-oily liquid such as glycerin with clays or with starch.

"Q. *Which of these materials are semi-pasty masses,* would you say, that you have just mentioned?

"A. I would say *all of these* materials are semi-pasty masses.

"Q. *Which of these materials are semi-pasty masses of the composition of paraffin?*

"A. Of those that I mentioned, the materials that will comply with that description are the petrolatum.

"The Court: That is the Vaseline?

"The Witness: Yes.

"By the Witness:

"A. (Continuing) *And the lubricating greases.*"

It is admitted by defendant that Texas Star-O is an ordinary lubricating grease (D. Br. 2, 16) and that this grease has been known for perhaps twenty years (P. App. 245-46).

Defendant has urged, and this Court's opinion has tacitly accepted the argument, that a "pulpy" material cannot be "greasy" or that a "pulpy" material *must* be something other than "greasy." This argument is not supported by the record of this case and was not accepted by the District Court. Initially defendant urged that a grease cannot be pulpy for the reason that a characteristic of a "pulpy" material is that it contains fibers or is fibrous in nature. However, this position has been abandoned because those skilled in the art are aware that lubricating greases such as Texas Star-O have a fibrous structure. This was admitted by one of defendant's witnesses (D. App. 385) and is substantiated by Dr. Miner's trial testimony (D. App. 29) and a standard textbook reference on greases by Klemgard (P. App. 223-27). The viscous pulpy nature of Texas Star-O grease is apparent from an examination of physical exhibit PX-114 which was demonstrated to this Court at the argument on appeal.

Dictionary definitions of "pulpy" and "pulp" are not restrictive to substances that are non-greasy but are broad enough to include greasy materials (P. App. 39-40, 229). Dr. Miner pointed out (D. App. 27-28) that even in the technical grease art the word "pulp" has been used to define a substance comprising a mixture of soap and oil, *i.e.*, an aluminum soap containing a small amount of mineral oil (P. App. 228).*

The evidence referred to above was presented by testimony in open court and amply supports the specific finding by the District Court that Texas Star-O grease is a viscous pulpy mass. *There was no conflicting witness testimony given at the trial relative to this matter.* It is respectfully submitted that under Rule 52 (a) this Finding of Fact No. 58, and related findings, should not have been set aside. This Court's opinion has erroneously accepted defendant's unsupported arguments concerning "pulpy" vis-a-vis "greasy" which are contrary to the witness testimony and other evidence on which the District Court based its findings.

There Is No File Wrapper Estoppel by the Cancellation of One Claim If the Retained Claim Reads Literally on the Accused Device.

Inasmuch as the term "viscous pulpy mass" used in the Henriksen patent claims literally embraces Texas Star-O grease, as found by the District Court, there can be no file wrapper estoppel resulting solely from the withdrawal of a claim reciting a "greasy substance" and replacing that claim with another claim which defines the follower material as a "viscous pulpy mass."

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*Texas Star-O grease is a mixture of calcium soap and a mineral oil (P. App. 245).

The case at bar is almost "on all fours" with *Ceramic Process Co.* v. *General Porcelain Enameling & Manufacturing Co.*, 129 F. 2d 803 (7 Cir. 1942), in which the patent in suit involved a method of applying designs to a vitreous surface utilizing a particular composition which was forced through a fine mesh onto the surface to be decorated. Claims were first submitted to the Patent Office which defined the composition as *paint-like*. These claims were later amended by reissue to define the composition as *pasty* in order more particularly to express a degree of viscosity. In litigation the defendant urged file wrapper estoppel on the ground that the accused method used a *paint-like* composition and, the term "paint-like" having been withdrawn from the original claims, the patent owner was estopped to assert that the claims properly embraced a process using the *paint-like* composition. This argument was rejected by the Court and Judge Sparks' opinion pointed out that even though defendant's composition was *paint-like*, it was also *pasty* and the process was within the ambit of the claims as amended.

In the case at bar, Henriksen cancelled claims 28, 29 and 30 which variously defined the follower as "viscous", "greasy" and "pulpy." New claim 31 was substituted for all of them and contained the term "viscous pulpy" which expressed a degree of consistency of the follower material which was not expressed in the earlier claims. Thus "viscous pulpy" was used to distinguish the claimed follower from the slug of liquid ink shown as a follower material in the capillary reservoir of the then newly cited Martin patent. It includes lubricating greases and other substances that are viscous and pulpy (P. App. 10). Similarly to the *Ceramics* case, Henriksen's withdrawn claim covered defendant's ball point pens but the new claim also literally reads on the accused devices and infringement is established.

The law is well settled that the doctrine of file wrapper estoppel is not applicable in cases where both withdrawn

and accepted claims read directly on the accused structure. *Smith* v. *Snow*, 294 U. S. 1, 15-16 (1935) and *Hunt* v. *Armour & Co.*, 185 F. 2d 722, 727 (7 Cir. 1950). In *North Star Ice Equipment Company* v. *Akshun Manufacturing Company*, 301 F. 2d 882 (7 Cir. 1962) and *Hubbell* v. *United States*, 179 U. S. 77 (1900) cited in this Court's opinion in the case at bar, the accused devices or methods lacked an element specified in the patent claims which was not present in the original cancelled claims. Each and every element specified in the Henriksen patent claims is found in the Autopoint ball point pens.

This Court's opinion quotes from the original Henriksen patent application and concludes (page 4):

> "The original specification thus appears to divide followers into two groups."

The implication is that Henriksen by election and amendment limited himself to claim only one of these groups (which one is not specified). However, *the distinction in the Henriksen application between the two groups is* **not** *based upon any difference in chemical composition which would separate greasy from nongreasy or pulpy from nonpulpy.* The given definition *for each group* obviously includes lubricating greases if it otherwise satisfies the specifications given. The District Court specifically found (F. F. 57, D. App. 416), and Dr. Miner and defendant's witness Mr. Nelson agreed (P. App. 10, 113-14), that Texas Star-O grease is a semi-pasty body of a composition of paraffin which defines a substance in the first group. The District Court also found that Texas Star-O grease is a viscous pulpy material (F. F. 58, D. App. 416) which is a characteristic of a follower included within the second group. This latter finding is supported by the evidence including Dr. Miner's trial testimony as previously noted (P. App. 10).

The Findings of the District Court Are Based on Witness Testimony and Should Not Be Depreciated for the Reason That They Were Drafted by Plaintiffs' Counsel.

In this Court's opinion the findings of the District Court relative to the viscous pulpy nature of Texas Star-O grease were set aside. In so doing these findings were depreciated for the reason that they "were entered in the precise form submitted by plaintiffs' counsel."

It has long been the practice in patent cases for the trial court to require counsel for the parties to submit proposed findings of fact and conclusions of law after the trial has been completed but before a decision is announced. This practice is specifically authorized under Rule 13 of the Civil Rules of the United States District Court for the Northern District of Illinois which reads as follows:

> "In any civil action, where findings of fact and conclusions of law are required, *the court may require from either or both parties, before or after the announcement of its decision, proposed findings of fact and conclusions of law,* for the assistance of the court, but, unless adopted by the court, such proposed findings of fact and conclusions of law shall not form any part of the record of the action."

In this case the proposed findings were carefully prepared and each is supported by the record. If this Court's opinion is allowed to stand, plaintiffs will be penalized because counsel took pains to draft findings supported by the record which could be and were adopted by the District Court "in the precise form submitted."

The attitude expressed in this Court's opinion in the case at bar is diametrically opposed to the prior decisions of this Court in *Taylor Instrument Companies* v. *Fee & Stemwedel, Inc.*, 129 F. 2d 156 (7 Cir. 1942) and *Hazeltine Research, Inc.* v. *Admiral Corp.*, 183 F. 2d 953, 954

(7 Cir. 1950). In the *Taylor Instrument* case Judge Sparks said (pp. 160-61):

> "Appellant more than once refers to the fact that the court adopted the findings tendered by appellee, thereby intimating, if not directly saying, that the court should have written its own findings. This is an old argument which is often resorted to by unsuccessful litigants. Each party, if he so desires, may present findings setting forth his theories and the evidence which he thinks support those theories. It then becomes the duty of the court to select the findings which it thinks are correct. If all or any part thereof are wrong they of course should be rejected. They may be restated in other language if the court so desires, or they may be adopted as requested if the court so desires. *If the court adopts them they become the court's findings regardless of who wrote them, and after that the only issue is their correctness, and we do not concern ourselves with their original authorship.*"

If it was the intention of this Court in the present case and in the more recent case, *Johnson & Johnson* v. *The Kendall Company*, Appeal No. 14227, decided January 22, 1964, to overrule the prior decisions in this circuit as established in the *Taylor Instrument* and *Hazeltine* cases, then it is respectfully suggested that the Court should have expressly done so in order to relieve uncertainty in future litigation.

Taylor-Reed Corporation v. *Mennen Food Products, Inc.*, 324 F. 2d 108 (7 Cir. 1963) was referred to in support of the propriety of setting aside findings of fact which the appellate court is able to resolve *on the basis of documentary evidence*. This Court then assumed that a proper basis for reversal was contained solely within the file wrapper of the Henriksen patent. This is a mistaken assumption. *The issue is whether the terminology "viscous pulpy mass" appearing in the patent claims as allowed by the Patent Office properly includes Texas Star-O*

grease. The findings of the District Court on this issue are supported by considerable evidence in the record of this case (P. Br. 30-38) including a substantial amount of witness testimony given before the District Court. This Court's construction of the claims, and more specifically its limited interpretation of the meaning of "viscous pulpy mass" is contrary to the weight of the evidence. The record in this case requires an affirmance of the District Court on the question of infringement.

Conclusion.

It is respectfully submitted that for the foregoing reasons this petition for rehearing should be granted. The District Court gave careful attention to the witness testimony and other evidence introduced during four and one half days of trial. The District Court particularly and carefully questioned the witnesses with respect to the properties of follower material compositions and ball point pen inks (P. App. 11, 12, 15, 18, 21, 23, 31, 48, 50, 52, 53, 56, 58, 59, 87, 94, 110; D. App. 24, 25, 28, 29, 41, 56). Extensive briefs were filed by both sides before and after trial. The findings of fact are supported by the record and the specific findings relating to the meaning of "viscous pulpy" are supported by witness testimony. It is respectfully urged that this Court should not have substituted the views expressed in argument by defendant's counsel for the District Court's findings and the record evidence.

Respectfully submitted,

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UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT
Chicago 10, Illinois

I, KENNETH J. CARRICK, Clerk of the United States Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing ..... pages contain a true copy of The Appellees' "Petition for Rehearing", filed in this Court on January 31, 1964.

Cause No. 14070

ERNST JOHAN HENRIKSEN and
W. A. SHEAFFER PEN COMPANY,
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v.

CORY CORPORATION,
Defendant-Appellant

as the same remains upon the files and records of the United States Court of Appeals for the Seventh Circuit.

IN TESTIMONY WHEREOF I hereunto subscribe my name and affix the seal of said United States Court of Appeals for the Seventh Circuit, at the City of Chicago, this thirteenth day of May, A.D. 1964.

KENNETH J. CARRICK,
Clerk of the United States Court of Appeals for the Seventh Circuit.

By: Thomas F. Strubbe, *Deputy Clerk*

[SEAL]

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HONORABLE RICHARD B. AUSTIN,
Trial Judge.

Answer To Petition For Rehearing.

The petition for rehearing sets forth no ground supporting the decision of the District Court that was not previously presented in the briefs and oral arguments made before this Court.

The three points upon which the petition is based will be answered individually.

THE PETITION FOR REHEARING REQUESTS THIS COURT TO DISREGARD THE ELECTION MADE BY THE PATENTEE IN THE PATENT OFFICE.

The admitted and indisputable facts appearing from the documentary evidence in the record establish that, (i) the patentee Henriksen, in order to secure his patent, gave the term "pulpy" an interpretation which excluded "greasy", and he specifically pointed out that "pulpy" and "greasy" followers were different and distinct species,

(ii) he elected the "pulpy" species and limited all his claims to such a follower pursuant to Rule 41 of the Patent Office, which requires that after such election the patent which subsequently issues must be restricted to the elected species.

The petition for rehearing in effect requests this Court to overlook the proceedings had in the Patent Office, to disregard the election which the patentee himself made in order to get his patent allowed, and to view the case as though the election of species had never been made.

The public is entitled to rely upon the representations made and the positions taken by the patentee before the Patent Office in order to secure his patent. The authorities supporting this position are numerous and this Court's decision applying the doctrine of file wrapper estoppel was eminently sound.

THE PETITION FOR REHEARING, IN ARGUING THAT TEXAS STAR "O" GREASE IS PULPY, IS NOT SUPPORTED BY THE RECORD.

A further point presented in the petition for rehearing is to the effect that the Defendant's Texas Star "O" grease is pulpy. In the first place, in order for the Plaintiffs to take this position they must presuppose that the Court had accepted the argument discussed in the preceding section, namely, that this Court would disregard the proceedings in the Patent Office, particularly the patentee's classification of "pulpy" and "greasy" as being different species and his election under Rule 41 to restrict his patent to the elected "pulpy" species.

The fact remains, however, that even if the patentee himself had not defined "pulpy" as being exclusive of "greasy", Defendant's Texas Star "O" grease is not

pulpy. Three well qualified witnesses were asked the direct question of whether or not Texas Star "O" grease is pulpy. They each answered in the negative. (See Appellant's Brief, page 25.) The fact that this testimony was by way of deposition rather than "at the trial" does not detract from it. Dr. Miner, upon whose testimony Plaintiffs rely heavily, not only never stated that Texas Star "O" grease was "pulpy", he admitted by his own testimony that his experience in connection with greases were "only in the most general sense", and that his only specific experiment with grease was "quite vague in my mind". (P. App. 14.) In any event, the interpretations of "pulpy" and "greasy" given by Dr. Miner long after the patentee himself had defined the terms to the Patent Office, are irrelevant and need not be considered.

THE FINDINGS OF FACT ON WHICH THE DISTRICT COURT BASED ITS DECISION ARE UNSUPPORTED IN THE RECORD.

The petition for rehearing takes the position that this Court depreciated the findings of the trial court simply because they were prepared by Plaintiffs' counsel. The fact is that the points on which Defendant heavily relies in this appeal are to be found in the documentary portion of the record and any "depreciation" of the District Court's findings are clearly warranted, not simply because the findings were prepared by petitioner's counsel, but because they perpetrate an erroneous legal position which ignores certain controlling facts, documentary in nature, and undisputed as to authenticity.

Conclusion.

Petitioners have not shown that this Court has misapprehended, misconceived, or overlooked any material matter of fact or law. All of the reasons against granting a rehearing obtain in this case; no reasons exist in favor of a

rehearing. (See *e.g.* Louisell "Rehearing in American Appellate Courts" 25 F. R. D. 143, 1960.)

The petition should be denied.

Respectfully submitted,

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UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

Chicago 10, Illinois

Wednesday, February 26, 1964

Before

HON. JOHN S. HASTINGS, *Chief Judge*
HON. F. RYAN DUFFY, *Circuit Judge*
HON. LATHAM CASTLE, *Circuit Judge*

No. 14070

ERNST JOHAN JENS HENRIKSEN, *et al.*,
Plaintiffs-Appellees,

v.

CORY CORPORATION,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

IT IS ORDERED by the Court that the petition for a rehearing of this cause be, and the same is hereby, denied.